THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 162

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DAVID M. RAPOPORT

Junior Party,

v.

WILLIAM C. DEMENT, MARK R. ROSEKIND
and JEFFREY L. SCHWIMMER

Senior Party.

Interference 102,760

FINAL HEARING: September 23, 1999

Before GRON, HANLON and SPIEGEL, Administrative Patent Judges.

GRON, Administrative Patent Judge.

Interference 102,760

FINAL DECISION

1. Background

February 12, 1990 -- Jeffrey L. Schwimmer (hereafter Schwimmer) filed Application 07/478,820. Original Claim 1 thereof reads in pertinent part:

> 1. A method for treatment of sleep apneas comprising administration of a therapeutically effective regimen of a Formula I azapirone compound[1] or a pharmaceutically effective acid addition salt thereof to a patient in need of such treatment . . . .

February 12, 1990 -- William C. Dement (hereafter Dement), Mark R. Rosekind (hereafter Rosekind), and Schwimmer filed Application 07/479,803. Original Claim 1 thereof reads in pertinent part:

> 1. A method for treatment of sleep apneas comprising administration of a therapeutically effective regimen of buspirone or a pharmaceutically effective acid addition salt thereof to a patient in need of such treatment.

February 14, 1990 -- David M. Rapoport (hereafter Rapoport) filed Application 07/479,693. Original Claim 1 thereof reads in pertinent part:

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[1] Although buspirone is an azapirone compound, the azapirone compounds of Schwimmer's Formula I appear to exclude buspirone.

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> 1. A method for treatment of sleep apneas comprising administration of a therapeutically effective regimen of a Formula I azapirone compound[2] or a pharmaceutically effective acid addition salt thereof to a patient in need of such treatment . . . .

February 12, 1991 -- Schwimmer filed Application 07/657,332, as a continuation of Application 07/478,820.

May 3, 1991 -- Dement, Rosekind, and Schwimmer (hereafter Dement et al.) filed Application 07/695,325, as a continuation-in-part of Applications 07/479,803 and 07/657,332. Original Claim 1 of Application 07/695,325 reads in pertinent part:

> 1. A method for treatment of sleep apneas comprising administration of a therapeutically effective amount of a Formula I azapirone compound[3] or a pharmaceutically effective acid addition salt thereof to a patient in need of such treatment . . . .

January 10, 1992 -- The Notice of Declaration of Interference 102,760 mailed January 10, 1992 (Paper No. 2), accorded senior party Dement et al. benefit of the February 12, 1990, filing date of Application 07/478,820; the February

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[2] The azapirone compounds of Rapoport's Formula I include buspirone. Dependent Claim 6 is directed to buspirone.

[3] The azapirone compounds of Dement et al. Formula I include buspirone. Dependent Claim 7 is directed to buspirone.

12, 1990, filing date of Application 07/479,803; and the February 21 [sic, 12], 1991, filing date of Application 07/657,332, for the subject matter of Count 1. Count 1 reads in pertinent part:

Count 1

> A method for treatment of sleep apneas comprising administration of a therapeutically effective amount of a Formula I azapirone compound[4] or a pharmaceutically effective acid addition salt thereof to a patient in need of such treatment . . . .

June 10, 1992 -- Rapoport filed a Motion Under 37 CFR §1.633(a)(Paper No. 12) arguing that (1) Dement et al. derived the invention of Count 1 from Rapoport, and (2) subject matter claimed in Dement et al. Application 07/695,325 is unpatentable over presentations in the U.S. by Rapoport on March 5, 1988, and March 11, 1989.

June 1, 1993 -- Rapoport filed a Motion To Accept Belated Filing Of Preliminary Motion Under 37 CFR 1.633(a)(Paper No. 51).

June 1, 1993 -- Rapoport filed a Motion For Judgment Under

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[4] The azapirone compounds of Formula I of Count 1 include buspirone. Claims 1-12 of Rapoport Application 07/479,693 and Claims 1-13 of Dement et al. Application 07/695,325 correspond to Count 1.

37 CFR §1.633(a) or 37 CFR §1.635 (Paper No. 52)(1) arguing that claims in Dement et al. Application 07/695,325 are unpatentable under 35 U.S.C. § 102(f), and (2) requesting authorization to take testimony of each joint inventor of Dement et al. on his contribution to inventorship.

June 24, 1993 -- Judge Sofocleous deferred Rapoport's motions filed June 1, 1993, to final hearing (Paper No. 56).

July 9, 1993 -- Rapoport filed a Second Motion To Accept Belated Filing Of Preliminary Motion Under 37 CFR 1.633(a)(Paper No. 63).

July 9, 1993 -- Rapoport filed a Motion For Judgment Under 37 CFR 1.633(a)(Paper No. 64) arguing that claims in Dement et al. Application 07/695,325 are unpatentable under 35 U.S.C.
§ 102(g)/103.

July 21, 1993 -- On reconsideration, Rapoport's request to modify Judge Sofocleous' June 24, 1993, decision to defer the motions Rapoport filed June 1, 1993, to final hearing, was denied by a three-judge panel (Paper No. 66).

August 4, 1994 -- Dement et al. filed (1) a Motion To Suppress Testimony of David M. Rapoport And Contingent Motion To Suppress Rapoport Exhibits 4, 5, 6, 10 and 11 Under 37 CFR

§1.635 and §1.656(h)(Paper No. 101), (2) a Motion To Suppress Rapoport Exhibits 10 and 11 Under 37 CFR §1.635 and §1.656(h)(Paper No. 101), (3) a Motion To Suppress Documentary Evidence Under 37 CFR §1.635 and §1.656(h)(Paper No. 101), and (4) a Motion To Suppress Cross-Examination Testimony Under 37 CFR §1.635 and §1.656(h)(Paper No. 101).

April 12, 1996 -- Rapoport's Motion Under 37 CFR §1.633(a) (Paper No. 12) for a judgment holding Claims 1-13 of Dement et al. Application 07/695,325 unpatentable as derived from Rapoport or unpatentable over Rapoport's presentations in the U.S., was denied by the Board (Paper No. 112). Senior party Dement et al. was awarded priority of the invention of Count 1 (Paper No. 112, pp. 18-19, bridging para.). According to the Board, Rapoport had not established that Dement et al. had derived the invention of Count 1 from Rapoport, because Dement et al. sustained their burden to establish a date of conception of the invention of Count 1 earlier than the date of conception established by Rapoport (Paper No 112, p. 9, last para.). The Board also determined (Paper No. 112, pp. 11-12, bridging para., and p. 12, first full para; footnotes omitted):

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> After having reviewed all the evidence submitted by Rapoport, we agree with Dement et al. that the two presentations given by Dr. Rapoport [on March 5, 1988, and March 11, 1989,] and the publications (RX 10 and 11) do not render the Dement et al. claims unpatentable. The Dement et al. claims are directed to a method for treatment of sleep apneas comprising administration of a therapeutically effective amount of an azapirone to a patient in need of such treatment, whereas Dr. Rapoport's presentations and publications (RX 10 and 11) disclose other methods, including one for treating anxiety, a condition other than sleep apnea. . . . [S]edatives, such as buspirone, would not have been expected to be useful for the treatment of sleep apnea due to the fact that arousal and motor tone in the upper airway would be reduced. To overcome sleep apnea when the airway collapses, a patient must awaken from sleep and if a patient is sedated, the patient might not awaken.

Thus, the Board denied Rapoport's Motion Under 37 CFR §1.633(a) (Paper No. 12) for judgment because Rapoport had not established that any claims of Dement et al. Application 07/695,325 are unpatentable (Paper No. 112, p. 10, first para.).

The Board also granted Rapoport's Motion To Accept Belated Filing Of Preliminary Motion Under 37 CFR 1.633(a)(Paper No. 51) for the reasons stated therein (Paper No. 112, p. 13, first full para.); granted-in-part Rapoport's Motion For Judgment Under 37 CFR §1.633(a) or 37 CFR §1.635 (Paper No. 52), allowing a testimony period but deferring judgment on the issue of the

patentability of Dement et al. claims under 35 U.S.C. § 102(f), to final hearing (Paper No. 112, p. 17, first para., pp. 18-19, bridging para.); denied Rapoport's Second Motion To Accept Belated Filing Of Preliminary Motion Under 37 CFR 1.633(a)
(Paper No. 63)(Paper No. 112, pp. 17-18, bridging para.), and dismissed Rapoport's Motion For Judgment Under 37 CFR 1.633(a) (Paper No. 64)(Paper No. 112, p. 18, first full para.).

July 12, 1996 -- Rapoport filed a Request For Reconsideration (Paper No. 116) of the Board's decision mailed April 12, 1996 (Paper No. 112).

August 14, 1996 -- Dement et al. filed Dement et al. Motion To Strike Rapoport Reply To Opposition To Request For Reconsideration And U.S. Patent Attached Thereto And Memorandum In Support Thereof (Paper No. 119).

September 6, 1996 -- Acting on Rapoport's Request For Reconsideration (Paper No. 116), the Board (1) declined to modify its decision of April 12, 1996 (Paper No. 122, pp. 5-6, bridging para.), and (2) dismissed as moot the Dement et al Motion To Strike Rapoport Reply To Opposition To Request For Reconsideration And U.S. Patent Attached Thereto And

Memorandum In Support Thereof (Paper No. 119) because Rapoport's reply

to the Dement et al. Opposition to Rapoport's Request For Reconsideration is not authorized by 37 CFR 1.658(b)(Paper No. 122, p. 2, second para.).

September 23, 1999 -- Final hearing ensues on Rapoport's Motion For Judgment Under 37 CFR §1.633(a) or 37 CFR §1.635 (Paper No. 52), the sole issue being the patentability under 35 U.S.C. § 102(f) of Claims 1-13 of Dement et al. Application 07/695,325, all of which correspond to Count 1 of this interference.

2. Prior Decisions of the Board

A. Conception of Invention of the Count

(1) "Rapoport has established conception of the invention of the count by May 13, 1988" (Decision, Paper No. 112, page 7, first full para.).

(2) "Dement et al. have sustained their burden to establish conception by the end of summer of 1986, a date prior to the May 13, 1988 conception of Rapoport, thereby defeating the Rapoport case for derivation" (Decision, Paper No. 112, p. 9, last para.).

B. Patentability

"We hold that Rapoport has not sustained his burden of proof to show that judgment should be entered against Dement et al" (Decision, Paper No. 112, p. 10, first para.). "[W]e agree with Dement et al. that the two presentations given by Dr. Rapoport and the publications . . . do not render Dement et al. claims unpatentable" (Decision, Paper No. 112, p. 11, last full sentence).

C. Priority of the Invention of the Count

"Rapoport has lost the priority contest and is not entitled to his claims corresponding to the count" (Decision, Paper No. 112, pp. 18-19, bridging para.).

3. Deferred Issue

Whether Rapoport has shown that Claims 1-13 of Dement et al. Application 07/657,332 are unpatentable under 35 U.S.C. § 102(f).

4. Supplemental Evidence Relevant To Deferred Issue

A. "As to claims 1, 2, 6, 7 and 13 of application Serial No. 07/695,325, the inventive entity comprises . . . Dement, . . . Rosekind and . . . Schwimmer. The date the conception of the invention as defined by those claims was complete was prior to April, 1986. The date the invention

defined by those claims was first reduced to practice was August 10, 1989" (Supplemental Record of the Party Rapoport (SRR) (Paper No. 147), Copies of Written Interrogatories And Answers Thereto Being Introduced Into Evidence (WIA), Response To Interrogatory No. 1 (RI 1), p. 257).

B. "As to claim 8 of application Serial No. 07/695,525 [sic, 07/695,325], the inventive entity comprises . . . Schwimmer. The date that the conception of invention defined by this claim was complete was the first half of 1989. . . . The date the invention defined by this claim was first reduced to practice was February 12, 1990" (SRR, WIA, RI 1, p. 257).

C. "As to claims 3-5 and 9-12 of application Serial No. 07/695,325, the inventive entity comprises . . . Schwimmer. The Date that the conception of the invention defined by those claims was complete was prior to February 12, 1990. . . . The date the invention defined by those claims was first reduced to practice was February 12, 1990" (SRR, WIA, RI 1, p. 257).

D. "For all claims in which . . . Dement is identified as an inventor in response to Interrogatory No. 1 [(RI 1)], his contribution to the conception of the invention was his concept, as disclosed to Wesley Seidel prior to April 1986, of

a method for treatment of sleep apnea comprising administration of a therapeutically effective amount of buspirone to a patient in need of such treatment . . . . The date when such contribution was made was prior to April, 1986. . . .” (SRR, WIA, RI 2, p. 258).

E. “Dement and . . . Rosekind conceived of at least a specific dosage of buspirone to be given to patients having sleep apnea at bedtime, i.e., 20 milligrams of buspirone. The date of this conception was prior to August 9, 1989. . . .” (SRR, WIA, RI 2, p. 259).

F. “For all claims in which . . . Rosekind is identified as an inventor in response to Interrogatory No. 1 [(RI 1)], his contribution to the conception of the invention was his concept, along with Dr. Dement of at least a specific dosage of buspirone to be given to patients having sleep apnea at bedtime, i.e., 20 milligrams of buspirone. The date of this conception was prior to August 9, 1989. . . .” (SRR, WIA, RI 3, p. 260).

G. “As to . . . claims 1, 2, 6, 7 and 13 of application Serial No. 07/695,325, the contribution of . . . Schwimmer to

the conception of the invention as a whole was as follows: . . . Schwimmer had the concept of the use of buspirone in the treatment of sleep apnea at least as early as May 19, 1988. The date when such contribution was made was May 19, 1988. . . .” (SRR, WIA, RI 4, pp. 261).

H. “[A]s to . . . claims 1, 2, 6, 7 and 13 of application Serial No. 07/695,325, . . . Schwimmer conceived of at least an upper limit of the dosage of buspirone for the treatment of sleep apnea recited in the last paragraph on page 4 of the Dement et al application involved in this interference, viz., 60 m.g.;
and a preferred upper limit of the dosage of buspirone for the treatment of sleep apnea recited in the last paragraph on page 9 of the Dement et al application involved in this interference, viz., 40 m.g. . . .” (SRR, WIA, RI 4, pp. 261-262).

I. “As to . . . claims 3-5 and 8-12 of application Serial No. 07/695,325, . . . Schwimmer conceived of the administration of a therapeutically effective amount of gepirone to a patient in need of such treatment for the treatment of sleep apnea in the first half of 1989; and of azapirones other than buspirone and gepirone for the treatment

of sleep apnea prior to February 12, 1990. . . .” (SRR, WIA, RI 4, pp. 262).

5. Patentability of Dement et al. Claims 1-13 Under § 102(f)

Claims 1-13 of Dement et al. Application 07/695,325, all the claims in the application, correspond to interference Count 1. Rapoport moves for judgment under 37 CFR § 1.633(a) (Paper No. 52) on the ground that subject matter of Claims 1-13 of Application 07/695,325, for which Dement, Rosekind and Schwimmer (Dement et al.) are named as joint inventors, is unpatentable under 35 U.S.C. § 102(f). As the moving party, Rapoport has the burden to establish that Claims 1-13 of Dement et al. Application 07/695,325 are unpatentable under 35 U.S.C.

§ 102(f). 37 CFR § 1.637(a). To satisfy this burden, Rapoport must show that Dement et al. did not jointly invent the subject matter sought to be patented, i.e., Rapoport must show that Dement, Rosekind and Schwimmer are not properly named as joint inventors of subject matter claimed in Dement et al. Application 07/695,325 as provided under 35 U.S.C. § 116.

The first paragraph of 35 U.S.C. § 116 provides:

> When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the

> required oath, except as otherwise provided in this title.
>
> Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

Accordingly, even if the evidence shows that the full scope of the invention defined by every one of Claims 1-13 of Application 07/695,325 is not the joint invention of Dement, Rosekind and Schwimmer, Rapoport has not thereby established that Dement, Rosekind and Schwimmer are not properly named as joint inventors of subject matter claimed in Application 07/695,325 under 35 U.S.C. § 116. Thus, it follows that even if the evidence shows that Dement, Rosekind and Schwimmer did not jointly conceive of the full scope of the invention defined by every one of Claims 1-13 of Application 07/695,325, Rapoport has not thereby established that Dement, Rosekind and Schwimmer are not properly named as joint inventors of subject matter claimed in Application 07/695,325 under 35 U.S.C. § 116. Therefore, even if the evidence to which Rapoport points shows that Dement, Rosekind and Schwimmer did not jointly conceive of the full scope of the invention defined by every one of Claims 1-13 of Application 07/695,325, Rapoport has not

thereby established that the subject matter of any one of Dement et al. Claims 1-13 is unpatentable under 35 U.S.C. § 102(f).

The evidence upon which Rapoport relies shows that Dement, Rosekind and Schwimmer did not physically work on the claimed subject matter together or at the same time. The evidence also shows that each of Dement, Rosekind and Schwimmer did not make the same type or amount of contribution to the claimed subject matter. Moreover, the evidence shows that at least one of Dement, Rosekind and Schwimmer made no contribution whatsoever

to the subject matter of at least one claim. Nevertheless, 35 U.S.C. § 116 expressly provides that this evidence does not establish that Dement, Rosekind and Schwimmer are not properly named as joint inventors of the subject matter claimed in Dement et al. Application 07/695,325.

In Kimberly-Clark Corp. v. Procter & Gamble Distrib. Co., 973 F.2d 911, 916, 23 USPQ2d 1921, 1925 (Fed. Cir. 1992), the court indicated that 35 U.S.C. § 116 reflects the Congressional intent to adopt and codify the principles of Monsanto Co. v. Kamp, 269 F. Supp. 818, 824, 154 USPQ 259, 262

(D.D.C. 1967). The Kimberly-Clark court identified those principles at 916-917, 23 USPQ2d at 1925-26:

> The court in *Monsanto*[] stated the pertinent principles as follows:
>
> > A joint invention is the product of *collaboration* of the inventive endeavors of two or more persons *working toward the same end* and producing an invention by their *aggregate* efforts. To constitute a joint invention, it is necessary that each of the inventors work on the same subject matter and make some contribution to the inventive thought and the final result. Each needs to perform but a part of the task if an invention emerges from all of the steps taken together. It is not necessary that the entire inventive concept should occur to each of the joint inventors, or that the two should physically work on the project together. One may take a step at one time, the other an approach at different times. One may do more of the experimental work while the other makes suggestions from time to time. The fact that each of the inventors plays a different role and that the contribution of one may not be as great as that of another does not detract from the fact that the invention is joint if each makes some original contribution, though partial, to the final solution of the problem.
>
> *Monsanto*, 269 F. Supp. at 262 [sic, 824], 154 USPQ at 262 (emphasis added).

The Monsanto court expressly stated that "[i]t is not necessary that the entire inventive concept should occur to each of the joint inventors. . . . One may do more of the

experimental work while the other makes suggestions from time to time." Monsanto Co. v. Kamp, 269 F. Supp. at 824, 154 USPQ at 262.

The different views of the parties to this interference proceeding on the issue whether Application 07/695,325 properly names Dement, Rosekind and Schwimmer as joint inventors of the claimed subject matter under 35 U.S.C. § 116 result from their failure to properly define the issue raised by Rapoport's motion. The question whether the subject matter claimed in Application 07/695,325 is unpatentable under 35 U.S.C. § 102(f) is different in scope than the question whether party Dement et al. should be awarded priority of invention of the subject matter of the interference count, the latter having been decided in favor of Dement et al. (Decision mailed April 12, 1996 (Paper No. 112) and Reconsideration mailed September 6, 1996 (Paper No. 122)). For example, to be patentable to a patent applicant, applicant's specification must have enabled one skilled in the art to make and use the *full scope* of the claimed invention in the manner provided by 35 U.S.C. § 112, first paragraph, at the time the application was filed. However, when determining priority of the invention to which an interference count is

drawn, it is only necessary that applicant's specification enable one skilled in the art to make and use *an embodiment* of the count in the manner provided by the first paragraph of 35 U.S.C. § 112. As a result,

the interference count may read on subject matter which is not patentable to either party to the interference, e.g., a phantom count. In Hunt v. Treppschuh, 523 F.2d 1386, 1389, 187 USPQ 426, 429 (CCPA 1975), the court stated:

> Another distinction is that Hunt's parent application is relied upon as a prior constructive reduction to practice; whereas in Smith v. Horne[, 450 F.2d 1401, 171 USPQ 755 (CCPA 1971)] the disclosure was relied upon for a right to make the count. In the latter situation the requirements of the first paragraph of 35 U.S.C. 112 must be satisfied for the *full scope* of the count. In the former, however, the § 112, first paragraph requirements need only be met for an *embodiment* within the count. The difference lies in the fact that a count is a vehicle for contesting priority and may not necessarily be allowable to a winning party or be proper under § 112 (e.g. a phantom count). Hedgewick v. Akers, 497 F.2d 905, 909 n.6, 182 USPQ 167, 169 n.6 (CCPA 1974).

Accord Squires v. Corbett, 560 F.2d 424, 433, 194 USPQ 513, 519 (CCPA 1977):

> The "count" . . . is merely the vehicle for contesting priority which . . . effectively circumscribes the interfering subject matter, thereby determining what evidence will be regarded as relevant on the issue of

> priority. The "count," as distinguished from a party's "claim," need not be patentable to either party in the sense of being fully supported by either party's disclosure.

Because the invention defined by the interference count need not be patentable to either party to the interference, the invention defined by the interference count may be unpatentable under 35 U.S.C. § 102(f). Similarly, the inventorship requirements of 35 U.S.C. § 116 do not apply to the full scope of the invention defined by an interference count. On the other hand, it is not disputed that the inventorship requirements of 35 U.S.C. § 116 must be met for the full scope of the subject matter claimed to be patentable to the named joint inventors.

Here, the issue raised by Rapoport's motion is unpatentability of the invention Dement et al. claim under 35 U.S.C. § 102(f), and the inventorship provisions of 35 U.S.C. § 116 certainly apply. Under Section 116, "[i]t is not necessary that the entire inventive concept should occur to each of the joint inventors. . . . One may do more of the experimental work while the other makes suggestions from time to time." Monsanto Co. v. Kamp, 269 F. Supp. at 824, 154 USPQ at 262.

Accepting that Monsanto Co. v. Kamp, supra, teaches that the entire inventive concept need not occur to each of the joint inventors for Dement et al. to be properly named as joint inventors under 35 U.S.C. § 116, Rapoport nevertheless argues that Rosekind and Schwimmer are not joint inventors of the invention Dement et al. claim. According to Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1575, 37 USPQ2d 1626, 1632 (Fed. Cir. 1996)(emphasis added):

> To be a joint inventor, one must contribute to the conception of an invention. *See Sewall v. Walters*, 21 F.3d 411, 415, 30 USPQ2d 1356, 1358-59 (Fed. Cir. 1994); 35 U.S.C. § 116 (1988). "Conception exists when a definite and permanent idea of an operative invention, including every feature of the subject matter sought to be patented, is known." *Id.* (citing *Coleman v. Dines*, 754 F.2d 353, 359, 224 USPQ 857, 862 (Fed. Cir. 1985)). "An idea is definite and permanent when the inventor has a specific, settled idea, a particular solution to the problem at hand, not just a general goal or research plan he hopes to pursue." *Burroughs Wellcome Co. v. Barr Lab., Inc.*, 40 F.3d 1223, 1228, 32 USPQ2d 1915, 1919 (Fed. Cir. 1994).

Rapoport points to the evidence that Dement's "contribution to the conception of the invention was his concept, as disclosed to Wesley Seidel prior to April 1986, of a method for treatment of sleep apnea comprising administration of a therapeutically effective amount of buspirone to a patient in

need of such treatment" (SRR, WIA, RI 2, p. 258; emphasis added), in support of his position.

While this evidence indicates that neither Rosekind nor Schwimmer contributed to Dement's conception of a method for treatment of sleep apnea comprising administration of a therapeutically effective amount of buspirone to a patient in need of such treatment, Rapoport has not thereby shown that (1) Schwimmer did not contribute to the concept of a method for treating sleep apnea comprising administration of therapeutically effective amounts of azapirones other than buspirone to a patient in need of such treatment and did not otherwise contribute to a patentable invention of Claims 1-13 of Application 07/695,325, or (2) Rosekind did not contribute to a patentable invention of Claims 1-13 of Application 07/695,325.[5] Rapoport has not established that Dement's conception of a method for treatment of sleep apnea comprising administration of a therapeutically effective amount of buspirone to a patient in need of such treatment itself constitutes a patentable invention, i.e. an

[5] In other words, Rapoport has not shown that Claims 1-13 of Application 07/695,325 would be patentable to Dement without the contributions of Schwimmer and Rosekind.

invention which is patentable under 35 U.S.C. § 112, first paragraph.

The evidence shows that Schwimmer at minimum contributed to the concept of a method for treating sleep apnea comprising administration of a therapeutically effective amount of azapirones other than buspirone to a patient in need of such treatment (SRR, WIA, RI 4, pp. 262). Therefore, his contribution to an invention claimed should not be suspect. However, the evidence also shows that Rosekind (1) contributed only to the invention of Claims 1, 2, 6, 7 and 13, and (2) along with Dement, contributed to the concept of a specific effective dosage of buspirone to be given to patients having sleep apnea at bedtime, i.e., 20 milligrams of buspirone (SRR, WIA, RI 2, p. 259; SRR, WIA, RI 3, p. 260). Rapoport argues that Rosekind's contribution to the claimed invention is entirely experimental and does not in any way relate to the conception of an invention claimed. Accordingly, Rapoport submits that Rosekind cannot be a joint inventor of an invention claimed and moves for judgment that Claims 1-13 are unpatentable under 35 U.S.C. § 102(f).

Thus, to be specific, the question presented by Rapoport's motion is whether Claims 1-13 of Application

07/695,325 must be unpatentable under 35 U.S.C. § 102(f) because one of the joint inventors, Rosekind, only contributed experimentation to reduce an embodiment within the scope of the claimed invention to practice, because Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d at 1575, 37 USPQ2d at 1632, states, "To be a joint inventor, one must contribute to the conception of an invention." Where, as here, unpatentability of a claimed invention under 35 U.S.C. § 102(f) is at issue, we interpret the above-quoted statement in Pro-Mold & Tool Co. to mean that each of the joint inventors must contribute to conception of a patentable invention claimed.

Conception alone may constitute a patentable invention if the invention conceived satisfies 35 U.S.C. § 112. However, "one need not necessarily meet the enablement standard of 35 U.S.C. § 112 to prove conception." Burroughs Wellcome Co. v. Barr Lab., Inc., 40 F.3d 1223, 1231, 32 USPQ2d 1915, 1922 (Fed. Cir. 1994). Accordingly, while Dement's conception of an invention encompassed by the interference count may be sufficient to establish priority as to the invention defined by an interference count, Rapoport has not shown that Dement's

conception of a method for treatment of sleep apnea comprising administration of a therapeutically effective amount of buspirone to a patient in need of such treatment itself, i.e., absent Rosekind's experimental contribution, constitutes conception of a patentable invention, i.e., an invention which satisfies the requirements of 35 U.S.C. § 112, first paragraph. More specifically, Rapoport has not shown that Claims 1, 2, 6, 7 and 13 of Application 07/695,325 would be patentable to Dement without Rosekind's contribution.

Whether or not an applicant reasonably believes that the invention will in fact work is irrelevant to conception of an invention. Burroughs Wellcome Co. v. Barr Lab., Inc., 40 F.3d at 1231, 32 USPQ2d at 1922 (emphasis added):

> The question is not whether Burroughs Wellcome reasonably believed that the inventions would work for their intended purpose . . . but whether the inventors had formed the idea of their use for that purpose in sufficiently final form that only the exercise of ordinary skill remained to reduce it to practice.

While conception may be the touchstone of inventorship, i.e., the completion of the mental part of an invention, and may show that the inventor had an idea that was definite and permanent enough that one skilled in the art could understand the invention, the inventor need not know or even reasonably

expect that the invention will work for conception to be complete. Burroughs Wellcome Co. v. Barr Lab., Inc., 40 F.3d at 1228-1229, 32 USPQ2d at 1919-1920. This is not to say that an inventor can never conceive of a patentable invention in an unpredictable or experimental field, such as the field of pharmaceutical therapy for treating sleep apneas, without reduction to practice, Id. at 1228, 32 USPQ2d at 1920, but it is not necessary for an inventor to reasonably expect success to establish conception of the invention defined by an interference count. However, to patent a claimed method of administering an amount of a pharmaceutical agent effective for treatment in the unpredictable art of treating sleep apneas, the patent applicant's specification must enable one skilled in the art to practice the full scope of the therapeutic method claimed without undue experimentation at the time the application was filed. Persons skilled in the art at the time of Dement's conception may very well have believed that success in practicing a therapeutic method for treating sleep apneas was so unpredictable that the ordinary or conventional kind of experimentation required to determine an effective amount of a single drug from a list of

potentially effective drugs having similar chemical structure would have been considered undue.

For example, In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991), teaches at 496, 20 USPQ at 1445 (footnote omitted):

> [W]e do *not* imply that patent applicants in art areas currently denominated as "unpredictable" must never be allowed generic claims encompassing more than the particular species disclosed in their specification. . . . However, there must be sufficient disclosure, either through illustrative examples or terminology, to teach those of ordinary skill how to make and use the invention as broadly as it is claimed. This means that the disclosure must adequately guide the art worker to determine, without undue experimentation, which species among all those encompassed by the claimed genus possess the disclosed utility.

PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996), states at 1564, 37 USPQ2d at 1623:

> In unpredictable art areas, this court has refused to find broad generic claims enabled by specifications that demonstrate the enablement of only one or a few embodiments and do not demonstrate with reasonable specificity how to make and use other potential embodiments across the full scope of the claim. See, e.g., In re Goodman, 11 F.3d 1046, 1050-52, 29 USPQ2d 2010, 2013-15 (Fed. Cir. 1993); Amgen, Inc. v. Chugai Pharmaceutical Co., 927 F.2d 1200, 1212-14, 18 USPQ2d 1016, 1026-28 (Fed. Cir.), cert. denied, 502 U.S.

856 (1991); In re Vaeck, 947 F.2d at 496, 20 USPQ at 1445.

The Patent and Trademark Office Board of Appeals stated in Ex parte Jackson, 217 USPQ 804, 807 (Bd. Pat. App. & Int. 1982) (emphasis added):

> The test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed to enable the determination of how to practice a desired embodiment of the invention claimed.

Just as Burroughs Wellcome Co. v. Barr Lab., Inc., 40 F.3d at 1229, 32 USPQ2d at 1920, teaches that "these cases do not stand for the proposition that an inventor can never conceive an invention in an unpredictable or experimental field until reduction to practice," the cases similarly do not stand for the proposition that conception itself is always sufficient to enable one skilled in the art to make and use the full scope of the claimed invention in an unpredictable or experimental field. One must examine the evidence in each case.

Burroughs Wellcome Co. v. Barr Lab., Inc., 40 F.3d at 1229, 32 USPQ2d at 1921, made clear (emphasis added):

> We . . . do not hold that a person is precluded from being a joint inventor simply because his contribution to a collaborative effort is experimental. Instead, the qualitative contribution of each collaborator is the key

> -- each inventor must contribute to the joint arrival at a definite and permanent idea of the invention as it will be used in practice.

In this case, there is ample evidence to reasonably support the proposition that persons skilled in this unpredictable art would not have considered Dement's conception alone to adequately enable persons having ordinary skill in the art to make and use the full scope of the invention claimed without the disclosure

of an effective therapeutic amount of at least one drug found effective for treating sleep apneas.

The evidence shows that Schwimmer recommended to Dement that he undertake a pilot study of buspirone and sleep apnea before any serious consideration for funding could be given. "Rosekind, who worked with Dr. Dement, called me on May 24, 1989 saying that they were serious about undertaking this pilot study, and in August, his first patient, a 62-year old male with sleep apnea, was studied" (Record of the Party Dement (RD), p. 9, Declaration of Jeffrey L. Schwimmer, para. 8; Dement Exhibit 8, para. 5). The evidence presented to Richard P. Ryan, a registered patent agent, at minimum suggested that "Dr. Schwimmer had worked with Drs. Dement and Rosekind . . . in reducing . . . [Dr. Dement's concept] to

practice . . .” (RD, p. 92, Declaration of Richard P. Ryan, para. 4). Based on Schwimmer’s testimony alone (RD, pp. 28-32; Deposition of Jeffrey L. Schwimmer, p. 15, l. 12, to p. 19, l. 13), persons skilled in the art may reasonably have considered the amount and kind of experimentation which would have been required to determine whether any given drug would be effective in the treatment of obstructive sleep apnea to constitute undue experimentation. Rapoport has not pointed to any evidence that undue experimentation would not have been required to determine whether any given drug would be effective in the treatment of obstructive sleep apnea.

To the contrary, in support of the contribution of each of Dement, Rosekind and Schwimmer to the invention of Claims 1, 2, 6, 7 and 13, Schwimmer’s testified:

> I made a trip to Stanford research to meet with Dement and Rosekind . . . . I met with them about trying to set up -- the possibility of setting up a research study in sleep apnea. . . . Most importantly, the concept of the protocol and initiating a protocol sleep research in terms of the design, feasibility, money.

(RD, pp. 59-60; Deposition of Jeffrey L. Schwimmer, p. 46, l. 16, to p. 47, l. 1);

> [I]f you think it works -- I would recommend . . . some pilot work and let’s see what happens . . . . If it looks good then we can use that as leverage to do more of a definitive study, but . . . I suggest you do some pilot work.

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. . . . .

> . . . I think I had earlier conversations in terms of agreeing to the design of the pilot study or how many patients and what the time frame would be for the pilot study. . . . I had a part to oversee and make sure that the pilot study had some integrity to it . . . .

(RD, p. 61; Deposition of Jeffrey L. Schwimmer, p. 48, l. 1-17).

Schwimmer's testimony combined with Rosekind's description of the amount and kind of experimentation which actually was performed as part of his clinical study (RD, pp. 73-78; Declaration of Mark R. Rosekind) and Yost's description of the same work (RD, pp. 79-84; Declaration of Doug Yost), reasonably support a finding that undue experimentation would have been required to practice the invention of Claims 1, 2, 6, 7 and 13 of Application 07/695,325 without the experimental contributions of Rosekind and Schwimmer. Moreover, on page 7 of the February 7, 1990 memorandum from R.P. Ryan/R.E. Carnahan to I Jarkovsky entitled "Buspirone in Sleep Apnea Patent Application: Inventorship/Ownership," it is observed that "reduction to practice may not be at all routine and easily accomplished"

(RD, p. 105).

Before the motion for judgment under 37 CFR § 1.633(a) can be granted, Rapoport must show that an invention claimed in Dement et al. Application 07/695,325 is unpatentable under 35 U.S.C. § 102(f). Rapoport has not met his burden. Rapoport has not shown that Dement, Rosekind and Schwimmer are not properly joined as inventors of a patentable invention claimed in Application 07/695,325. In short, Rapoport has not shown that Application 07/695,325 names an inventive entity which is not proper under 35 U.S.C. § 116. Accordingly, we deny Rapoport's Motion For Judgment Under 37 CFR §1.633(a)(Paper No. 52).

Concomitantly, Rapoport has not shown that the preliminary statement of Dement et al., referring to initial disclosure and conception of the invention defined by the interference count in 1986 "by the inventors" (Preliminary Statement Of Dement et al., Paper No. 10, para. 4 and 3), is incorrect. The Board held, consistent with the joint inventorship provisions of 35 U.S.C. § 116 (1984), that the conception by Dement of an embodiment of the interference count inures to the benefit of the inventive entity of the Dement et al. application (Decision mailed

April 12, 1996 (Paper No. 112), p. 9, first full para.).

Not only has Rapoport failed to show that the joint inventors named in Application 07/695,325 for the subject matter claimed are improper under 35 U.S.C. § 116 and Claims 1-13 of Application 07/695,325 are unpatentable under 35 U.S.C. § 102(f), but Rapoport also has not shown that the Board erred in its decision awarding priority of the invention defined by the count of this interference to senior party Dement et al. based on Dement's earlier conception of a method for treatment of sleep apneas comprising administration of a therapeutically effective regimen of buspirone to a patient in need of such treatment (Papers No. 112 and 122). Therefore, we will not *sua sponte* reject any of the claims pending in Dement et al. Application 07/695,325 as being unpatentable under 35 U.S.C. § 102(g)/103(a). In that the Board denied Rapoport's Second Motion To Accept Belated Filing Of Preliminary Motion Under 37 CFR 1.633(a)(Paper No. 63)(Paper No. 112, pp. 17-18, bridging para.) and dismissed Rapoport's Motion For Judgment Under 37 CFR 1.633(a) (Paper No. 64)(Paper No. 112, p. 18, first full para.), our consideration of the patentability issues for final hearing is complete.

6. Decisions on Miscellaneous Motions

A. Dismissed Motions To Suppress

On August 4, 1994, Dement et al. filed (1) a Motion To Suppress Testimony of David M. Rapoport And Contingent Motion To Suppress Rapoport Exhibits 4, 5, 6, 10 And 11 Under 37 C.F.R. §1.635 And §1.656(h)(Paper No. 101), (2) a Motion To Suppress Rapoport Exhibits 10 and 11 Under 37 C.F.R. §1.635 And §1.656(h) (Paper No. 101), and (3) a Motion To Suppress Documentary Evidence Under 37 C.F.R. §1.635 And §1.656(h)(Paper No. 101). The Board considered Rapoport Exhibits 4, 5, 6, 10, 11, 26, 37, 41 and 42 in its Decision mailed April 12, 1996 (Paper No. 112, p. 11, l. 3 (RX 42), p. 11, first full para. (RX 10 & 11); pp. 11-12, bridging para. (RX 10 & 11); p. 12, first full para. (RX 10 & 11); p. 14 (RR 193-198, i.e., RX 37); p. 15, l. 2-3 (RR 145-146, i.e., RX 26); p. 16, first full para. (Document 32, i.e., RR 207/RX 41)). In footnote 3 on page 11 of its Decision mailed April 12, 1996 (Paper No. 112), the Board dismissed the motions as moot:

> Dement et al. have filed two motions to suppress testimony and certain evidence relied upon by Rapoport. The motions

> to suppress are dismissed as moot, since the evidence in toto is insufficient to demonstrate unpatentability.

On August 4, 1994, Dement et al. also filed a Motion To Suppress Cross-Examination Testimony Under 37 C.F.R. §1.635 and §1.656(h)(Paper No. 101). On page 16 of its Decision mailed April 12, 1996 (Paper No. 112), the Board dismissed this motion as moot:

> The Dement et al. motion to suppress the cross-examination of Dr. Schwimmer on the question of improper inventorship is dismissed as moot inasmuch as we did not consider that testimony in deciding to grant Rapoport a testimony period on his motion.

As indicated above, all Dement et al. motions to suppress evidence appear to have been dismissed. Rapoport is not entitled to raise dismissed motions at final hearing. See 37 CFR § 1.655(b).

Moreover, Dement et al. acknowledge that “Rapoport Exhibits 12-21 and 24-41 are documents produced by Dement et al to Rapoport; and Rapoport Exhibits 42, 43 and 44 are documents which were attached to the Rapoport ‘Motion Under 37 C.F.R. §1.633(a)’ which was served on Dement et al on June 10, 1992" (Motion To Suppress Documentary Evidence Under 37 C.F.R. §1.635 And §1.656(h)(Paper No. 101), p. 1, footnote 1). Thus, the documentary evidence or other exhibits were sufficiently

identified and their significance was discussed with particularity by the parties in Rapoport's written interrogatories and requests for production of documents and the comments and submissions of party Dement et al. in response thereto (e.g., see Copies of Written interrogatories and Answers Thereto Being Introduced Into Evidence (RR 060-077)) and Rapoport's motion. Accordingly, party Dement et al. has not shown that it has been prejudiced by the Board's consideration of any of the criticized exhibits and/or documentary evidence or burdened by any considerable difficulty in presenting and evaluating the evidence relevant to the issues presented by this interference, the apparent focus of 37 CFR §1.671(f)(Motion To Suppress Documentary Evidence Under 37 C.F.R. §1.635 And §1.656(h)(Paper No. 101), p. 2, Full Statement of the Reasons Why the Relief Requested Should be Granted).

B. Motion To Strike Portions Of Rapoport Brief

Dement et al. filed a Motion To Strike Portions Of Rapoport Brief (Paper No. 148) on February 20, 1998. Judge Sofocleous deferred consideration of the motion to final hearing (Paper
No. 153).

Dement et al. argue that their motion should be granted because Rapoport's Brief raises issues beyond the single remaining issue of unpatentability of Claims 1-13 of Application 07/695,325 under 35 U.S.C. § 102(f). We deny the motion. To consider the issue of unpatentability of the subject matter Dement et al. claim under 35 U.S.C. § 102(f), we must ask whether the joint inventors named in Application 07/695,325 invented the subject matter sought to be patented. Rapoport's motion under 37 C.F.R. §1.633(a) certainly opens a Pandora's Box of questions regarding (1) the preliminary statements of joint inventorship and conception, (2) the Board's prior decision on priority of invention, and (3) the patentability of the subject matter claimed in Application 07/695,325 under 35 U.S.C. § 102(g)/103. While we might literally strike from Rapoport's Brief all references to matters which relate to patentability under 35 U.S.C. § 102(f), their relationship to the single issue before us is apparent. Because our discussion and disposition of the Section 102(f) issue predisposes the related issues raised in Rapoport's Brief, we deny the Dement et al. motion to strike all references thereto from Rapoport's Brief.

7. Decisions on Preliminary Motions

A. Rapoport's Motion Under 37 CFR §1.633(a) filed June 10, 1992 (Paper No. 12), arguing that Dement et al. claims are unpatentable under 35 U.S.C. § 102(a) or § 103 because (1) Dement et al. derived the invention of Count 1 from Rapoport, and (2) Dement et al. claims are unpatentable over presentations in the U.S. by Rapoport on March 5, 1988, and March 11, 1989,
was DENIED by Decision mailed April 12, 1996 (Paper No. 112) and Reconsideration mailed September 6, 1996 (Paper No. 122).

B. Rapoport's Motion To Accept Belated Filing Of Preliminary Motion Under 37 CFR 1.633(a) filed June 1, 1993 (Paper No. 51), was GRANTED by Decision mailed April 12, 1996 (Paper No. 112) and Reconsideration mailed September 6, 1996 (Paper No. 122).

C. Rapoport Second Motion To Accept Belated Filing Of Preliminary Motion Under 37 CFR 1.633(a) filed July 9, 1993 (Paper No. 63) was DENIED by Decision mailed April 12, 1996 (Paper No. 112) and Reconsideration mailed September 6, 1996 (Paper No. 122).

D. Rapoport Motion For Judgment Under 37 CFR 1.633(a) filed July 9, 1993 (Paper No. 64), arguing that Dement et al.

claims are unpatentable under 35 U.S.C. § 102(g)/103 was DISMISSED by Decision mailed April 12, 1996 (Paper No. 112) and Reconsideration mailed September 6, 1996 (Paper No. 122).

E. Rapoport's deferred Motion For Judgement Under 37 CFR §1.633(a) or 37 CFR §1.635 filed June 1, 1993 (Paper No. 52), arguing that Dement et al. claims are unpatentable under 35 U.S.C. § 102(f), is hereby DENIED.

The Board's prior Decision mailed April 12, 1996 (Paper No. 112) and Reconsideration mailed September 6, 1996 (Paper No. 122), including its judgement as to the patentability of claims in Dement et al. Application 07/695,325 and award of priority of the invention of Count 1 of Interference 102,760, are hereby incorporated by reference and included in the attached Appendix. We do not review the prior decisions of the Board.

8. Final Disposition

For Interference 102,760, it is

ORDERED that judgement on priority as to the Count 1, the sole count in this interference, is awarded against junior party

DAVID M. RAPOPORT;

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FURTHER ORDERED that judgment on priority as to Count 1 is awarded in favor of senior party WILLIAM C. DEMENT, MARK R. ROSEKIND and JEFFREY L. SCHWIMMER;

FURTHER ORDERED that, on the record before the Board of Patent Appeals and Interferences, senior party WILLIAM C. DEMENT, MARK R. ROSEKIND and JEFFREY L. SCHWIMMER, is entitled to a patent containing Claims 1-13 (corresponding to Count 1) of Application 07/695,325, filed May 3, 1991; and

FURTHER ORDERED that, on the record before the Board of Patent Appeals and Interferences, junior party DAVID M. RAPOPORT, is not entitled to a patent containing Claims 1-12 of Application 07/479,693, filed February 14, 1990.

It is

ORDERED that if there is a settlement and it has not already been filed, attention is directed to 35 U.S.C. § 135(c) and
37 CFR § 1.661; and

FURTHER ORDERED that a copy of this decision be given an appropriate paper number and entered into the file records of Applications 07/695,325 and 07/479,693.

The periods for response to this our decision and all the other panel decisions in Interference 102,760 shall run concurrently with the period for responding hereto.

TEDDY S. GRON Administrative Patent Judge	)	
	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CAROL A. SPIEGEL Administrative Patent Judge	)	

bae

HANLON, Administrative Patent Judge, concurring.

A panel of this board has decided priority, determining that "Rapoport has lost the priority contest and is not entitled to his claims corresponding to the count." Paper No. 112, p. 18. One outstanding motion remains, a motion for judgment under 37 CFR § 1.633(a), wherein Rapoport moves for judgment on the ground that claims 1-13 of Dement et al. ("Dement") application 07/695,325, corresponding to Count 1, are not patentable to Dement. See Paper No. 52. The issue raised by that motion, and the sole issue currently before this panel, is whether Rapoport has shown that claims 1-13 of the Dement application are unpatentable under 35 U.S.C. § 102(f). I agree with the decision, reached by the majority, that junior party Rapoport has not sustained its burden of establishing improper inventorship of the Dement application and add the following comments thereto.

According to the record in this interference, the contributions of Dement, Rosekind and Schwimmer to the invention of claims 1-13 in Dement application 07/695,325 include (majority opinion, pp. 10-12):

> D. "For all claims in which . . . Dement is identified as an inventor in response to Interrogatory No. 1 [(RI 1)], his contribution to the conception of the invention was his concept, as disclosed to Wesley Seidel prior to April 1986, of a method for treatment of sleep

> apnea comprising administration of a therapeutically effective amount of buspirone to a patient in need of such treatment . . . . The date when such contribution was made was prior to April, 1986. . . ." (SRR, WIA, RI 2, p. 258). . . .
>
> F. "For all claims in which . . . Rosekind is identified as an inventor in response to Interrogatory No. 1 [(RI 1)], his contribution to the conception of the invention was his concept, along with Dr. Dement of at least a specific dosage of buspirone to be given to patients having sleep apnea at bedtime, i.e., 20 milligrams of buspirone. The date of this conception was prior to August 9, 1989. . . ." (SRR, WIA, RI 3, p. 260). . . .
>
> H. "[A]s to . . . claims 1, 2, 6, 7 and 13 of application Serial No. 07/695,325, . . . Schwimmer conceived of at least an upper limit of the dosage of buspirone for the treatment of sleep apnea recited in the last paragraph on page 4 of the Dement et al application involved in this interference, viz., 60 m.g.; and a preferred upper limit of the dosage of buspirone for the treatment of sleep apnea recited in the last paragraph on page 9 of the Dement et al application involved in this interference, viz., 40 m.g. . . ." (SRR, WIA, RI 4, pp. 261-262).

Rapoport argues that Rosekind and Schwimmer are not properly named as inventors in the Dement application since the particular dosages said to have been conceived by Rosekind and Schwimmer do not appear in any claim of Dement application 07/695,325. Rapoport further urges that the inventorship of the Dement application is improper since William C. Dement,

alone, conceived of the claimed "therapeutically effective amount" of buspirone prior to April 1986.

As the moving party, Rapoport bears the burden of establishing improper inventorship by clear and convincing evidence. Hess v. Advanced Cardiovascular Sys., Inc., 106 F.3d 976, 980, 41 USPQ2d 1782, 1785 (Fed. Cir. 1997) (stating that

" '[t]he burden of showing misjoinder or nonjoinder of inventors is a heavy one and must be proved by clear and convincing evidence' " (quoting Garrett Corp. v. United States, 422 F.2d 874, 880, 164 USPQ 521, 526 (Ct. Cl. 1970))).

Rapoport appears to equate Dement's conception of an embodiment within the scope of the count prior to April 1986 with inventorship of the claimed invention under 35 U.S.C. § 116. However, being the first to conceive an embodiment within the scope of the count on a particular date is not the same as conceiving the full scope of each claim in the application as of its date of original presentation. Therefore, the fact that Dement was the first to conceive an embodiment within the scope of the count at some earlier date does not establish inventorship under 35 U.S.C. § 116 of each

one of claims 1-13 of the Dement application as of its date of original presentation.

The Court in Ethicon Inc. v. U.S. Surgical Corp., 135 F.3d 1456, 1460, 45 USPQ2d 1545, 1548 (Fed. Cir. 1998), explains conception of a joint invention as follows:

> A patented invention may be the work of two or more joint inventors. See 35 U.S.C. § 116 (1994). Because "[c]onception is the touchstone of inventorship," each joint inventor must generally contribute to the conception of the invention. . . .
>
> [F]or the conception of a joint invention, each of the joint inventors need not "make the same type or amount of contribution" to the invention. 35 U.S.C. § 116. Rather, each needs to perform only a part of the task which produces the invention. . . .
>
> Furthermore, a co-inventor need not make a contribution to every claim of a patent. See 35 U.S.C. § 116. A contribution to one claim is enough. . . . Thus, the critical question for joint conception is who conceived, as that term is used in the patent law, the subject matter of the claims at issue.

The record establishes that both Schwimmer and Rosekind conceived of specific dosages, 60 milligrams, preferably 40 milligrams, and 20 milligrams, respectively, of buspirone to be administered to patients for the treatment of sleep apnea. These dosages fall within the broad scope of the claimed

"therapeutically effective amount" of buspirone in claim 1,[6] and although not expressly claimed, the dosages are species within the broad genus of "a therapeutically effective amount" of buspirone. See Dement brief, pp. 11-12. Therefore, Dement, Schwimmer and Rosekind each contributed to the subject matter of at least one claim of Dement application 07/695,325. Compare Ethicon, 135 F.3d at 1463, 45 USPQ2d at 1550-51 ("The contributor of any disclosed means of a means-plus-function claim element is a joint inventor as to that claim, unless one asserting sole inventorship can show that the contribution of that means was simply a reduction to practice of the sole inventor's broader concept."). Accordingly, there is no violation of 35 U.S.C. § 116, and the motion for judgment against senior party Dement on the grounds that its claims are unpatentable under 35 U.S.C. § 102(f) must fail. Rapoport has failed to establish otherwise. See Hess, 106 F.3d at 980, 41 USPQ2d at 1785 (the burden of showing misjoinder must be proved by clear and convincing evidence) (quoting Garrett, 422 F.2d at 880, 164 USPQ at 526).

[6] Claim 1 is the sole independent claim in the Dement application.

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	)	BOARD OF PATENT
ADRIENE LEPIANE HANLON	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES

Interference 102,760

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APPENDIX